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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/787,113	02/27/2004	Shinetsu Fujieda	249507USOTTICRD	5083
22850 7590 08/29/2008 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
SELLERS, ROBERT E				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
08/29/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/787,113

Applicant(s)

FUJIEDA ET AL.

Examiner

ROBERT SELLERS

Art Unit

1796

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 9, 11 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10 and 13-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

Claims 9, 11 and 12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to non-elected species of the disposition of the epoxy resin, there being no allowable generic or linking claim. The election was made **without** traverse in the reply filed on September 28, 2006.

1. The 35 U.S.C. 112, first and second paragraphs rejections are hereby rescinded due to the insertion of the protection of the electronic circuit from the leakage of nonaqueous solvent from the battery into independent claims 1, 15 and 20 as suggested in the non-Final rejection mailed January 22, 2008 on page 3 in paragraph 2.

The text of section 103(a) of Title 35, U.S. Code not included in this action can be found in the non-Final rejection.

Claims 1-8, 10 and 13-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clayton Patent No. 6,049,975; Goldner et al. Patent No. 6,982,132 and Japanese Patent No. 2001-2757 (Japanese '757) in view of Murai et al. Patent No. 6,437,090 and Japanese Patent Nos. 58-187425 (Japanese '425) and 62-74919 (Japanese '919).

The rejection is maintained for the reasons of record set forth in the previous Office actions. The arguments filed July 22, 2008 have been considered but are unpersuasive.

2. Japanese '757 (Derwent abstract, Advantage section and translation, page 2, paragraph 7, lines 8-9 and page 7, paragraph 44) teaches a polyepoxide protective coating for an electronic circuit having high resistance to an electrolyte solution such as a non-aqueous mixture of γ -butyrolactone and ethylene carbonate, thereby meeting the newly claimed protection of the electronic circuit from a non-aqueous solvent from a lithium ion battery.

According to MPEP § 2144.01, section IV. Rationale Different from Applicant's Permissible:

"The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant (*In re Kahn*, 78 USPQ2d 1329, 1336, Federal Circuit 2006).

3. The motivation of the epoxy resin protective overcoat of Clayton (col. 17, lines 62-65 and col. 18, lines 55-64) is to mitigate the harm of environmental hazards including atmospheric moisture and surface contamination. The reason for the epoxy resin encapsulant for the lithium electrochemical cell of Goldner et al. (col. 13, lines 47-56) is to prevent the degradation from exposure to atmospheric moisture or oxygen. Although such a motivation and reason is for a different purpose or to solve a different problem, it remains a suitable rationale based on MPEP § 2144.01, section IV and *In re Kahn*.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

(571) 272-1093 (Fax No. (571)-273-8300)
Monday to Friday, 9:30 to 6:00

/Robert Sellers/
Primary Examiner
Division 1796

rs
8/26/2008